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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN T. MCHALE AND JEROME KATZ

Appeal 2009-002337
Application 09/993,243
Technology Center 3600

Decided: August 28, 2009

Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1, 3, 5, 7-25, 29, 30, 32-47, and 54-72. We have jurisdiction under 35 U.S.C. § 6(b). (2002) An Oral Hearing was held on August 13, 2009.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants claim a system and method for serving patrons of restaurants bars and the like using interactive ordering systems.
(Specification 4:27,28)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A patron service system for serving at least one patron of an establishment, said system comprising:
 - at least one patron station located in said establishment and configured to electronically display a plurality of menu items and electronically display at least one advertisement thereon, each patron station also being configured to receive order input from a patron corresponding to an order of at least one of said menu items;
 - an establishment server in communication with each patron station, said establishment server comprising (1) a database for storing a plurality of advertisements and (2) an advertisement selection program for selecting which of said stored advertisements are to be communicated to said at least one patron station for display thereon, said establishment server being configured to (1) receive and

process said order input for later fulfillment of said order, (2) execute said advertisement selection program, and (3) communicate the advertisement selected upon execution of the advertisement selection program to said at least one patron station for display thereon; and
a central server in communication with said establishment server, said central server being configured to communicate at least a portion of said advertisement selection program to said establishment server.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Kurland	4,553,222	Nov. 12, 1985
Ragsdale-Elliott	6,636,835 B2	Oct 21, 2003

The following rejections are before us for review.

The Examiner rejected claims 1, 3, 5, 7, 12, 14, 16, 17, 19, 57-60 and 65 under 35 USC §102(e) as being anticipated by Ragsdale-Elliott.

The Examiner rejected claims 8-11, 13, 15, 18, 20, 24, 25, 29, 30, 32-35, 39-47, 54-56, 61-64, and 66-73 under 35 USC §103(a) as being unpatentable over Ragsdale-Elliott in view of Examiner's Official Notice.

The Examiner rejected claims 21-23 and 36-38 have been rejected under 35 USC §103(a) as being unpatentable over Ragsdale-Elliott in view of Kurland.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1, 3, 5, 7, 12, 14, 16, 17, 19, 57-60 and 65 under 35 USC §102(e) as being anticipated by Ragsdale-Elliott on the grounds that the downloaded photo-image of a menu item in Ragsdale-Elliott constitutes an advertisement of that menu item?

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631(Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found that Ragsdale-Elliott discloses all the limitations of claim 1. (Answer 3-5).
2. In finding that Ragsdale-Elliott discloses all the limitations of claim 1, the Examiner found that Ragsdale-Elliott discloses “[a] central server (such as, an internet server containing a database of photo-images as disclosed in col. 5 ll. 36) in communication with the establishment server....” (Answer 4-5)
3. The Examiner found that the photo-images of menu items presented on a touch screen monitor in Ragsdale-Elliott are advertisements. (Answer 4)
4. Ragsdale-Elliott discloses an additional server at an internet site which communicates with a server 10 in that,
a first touch screen monitor 18 which displays menu driven software by a visual set of images [is] linked to preselected food or product menu items according to a specific restaurant cuisine or product line. Such, image data can be obtained by original photo-images made by the restaurant owner or the like to represent a selective set of menu items or can be scanned or digitally transferred to a database and/or downloaded/uploaded from an authorized internet or other image database for linking to a selective menu item or set of items thereof.
(Ragsdale-Elliott, col. 5, ll.32-41)

5. Appellants' Specification does not specifically define the terms advertisement or advertise, nor does it utilize the terms contrary to their customary meaning.

6. The Examiner found that the ordinary and customary definition of advertising is "[t]he action of attracting public attention to a product or business." (Answer 15)

7. The Examiner further found that the downloading of selective photo-image of menu items by the internet database server constitutes communication of "...at least a portion of the advertisement selection program as it contains a photo-image or a link to a photo-image in HTML, JavaScript or and other related programming designed for enhanced visual graphic viewing." (Answer 5)

ANALYSIS

We affirm the rejections of claims 1, 3, 5, 7-25, 29, 30, 32-47, and 54-72.

Initially, we note that the Appellants argue claims 1, 3, 5, 7, 12, 14, 16, 17, 19, 57-60 and 65 together as a group. Correspondingly, we select as representative claim 1 to decide the appeal of these claims, remaining claims standing or falling with claim 1.

Appellants assert error in the Examiner's prima facie case of anticipation of claim 1 by Ragsdale-Elliott because "...Ragsdale-Elliott fails to disclose a separate central server capable of communicating at least a portion of an advertisement selection program to an establishment server." (Appeal Br. 4)

The Examiner however maintains that because the internet database server downloads photo-images of menu items to the restaurant server for presentation on the touch screen monitor, the internet database server meets the claim requirement of a central server in communication with said establishment server, said central server being configured to communicate at least a portion of said advertisement selection program to said establishment server. (Answer 4-5) To make this finding, the Examiner additionally found that, 1. the definition of advertising is: the action of attracting public attention to a product or business (FF 6), and 2. that the photo-images of menu items presented on a touch screen monitor in Ragsdale-Elliott are advertisements. (FF 3).

Appellants, however, assert that a

...logical reading of its claims requires "advertisements" to be construed as something above and beyond the display of menu items. First, the elements are claimed separately - the patron station is "configured to electronically display a plurality of menu items *and* electronically display at least one advertisement thereon." Claim 1 (emphasis added). Additionally, when interpreted in light of the specification (including the Summary of Invention and Figure 9), it would be clear to one of ordinary skill in the art that the "advertisements" are something separate from the menu items.

(Appeal Br. 4)

In light of the breadth of the claim, the Appellants' arguments are not persuasive as to error in the rejection. This is because the Examiner found that the definition of advertise only generally refers to an action of attracting public attention to a product (FF 6). Appellants argue an interpretation of

“advertisement” based on given portions of the Specification, but we find that the Specification does not specifically define the term advertise, nor does it utilize the term contrary to its customary meaning (FF 5). Thus, given these findings, we find that an image, for example, of a juicy hamburger on a toasted bun placed adjacent the menu item word “hamburger” attracts attention to something which would otherwise be mere words, and hence is an advertisement for the word “hamburger”.

Second, since Ragsdale-Elliott discloses that a menu item is linked to a selective image (FF 4), the system is thus configured to electronically display a plurality of menu items *and* electronically display at least one advertisement thereon because the linking connects the advertisement image to the menu item words.

Appellants further argue that nothing in Ragsdale-Elliott “...meet[s] the limitations required of the central server - namely the communication of an advertisement selection program.” (Appeal Br. 4)

In light of the breadth of the claim, the Appellants’ argument is not persuasive as to error in the rejection. That is, the Examiner found that the downloading of selective photo-image of menu items by the internet database server constitutes communication of “...at least a portion of the advertisement selection program as it contains a photo-image or a link to a photo-image in HTML, JavaScript or and other related programming designed for enhanced visual graphic viewing.” (FF 7). Thus, the Examiner made findings of fact regarding the prior art and applied them to the claim, in this case the advertisement selection program, to present a prima facie case in support of the rejection. To rebut such a prima facie case, the burden of coming forth with evidence, shifts to the Appellants. The Appellants

have presented no such evidence of error in the Examiner's findings, but instead allege error in a conclusory manner.

Finally, Appellants present new evidence in their Reply Brief asserting that Ragsdale-Elliott is an invalid reference because the presently appealed application is a CIP application based on a parent application whose filing date predates it. Rule 41.41 states unequivocally that a reply brief shall not include new evidence. Thus, the evidence presented by Appellants is untimely and cannot be considered.

We note that even if this evidence of the subject matter of Appellants' parent application was timely presented to us for consideration on review, it would still not meet Office requirements for establishing a priority date for the CIP where the parent date is necessary for overcoming a reference. This is because the Office requires determinations to be made in addition to the statements presented by Appellants in their Reply Brief before crediting an applicant a priority date for a CIP application. For example, the Manual of Patent Examining Procedures (MPEP) § 201.08, states that where the date of a non-provisional application is actually needed to overcome a reference, as it is here, the Office needs

...to make a determination as to the requirement of 35 U.S.C. § 120, that the earlier non-provisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. § 112, is met and whether a substantial portion of all of the earlier non-provisional application is repeated in the second application in a continuation-in-part situation.

Such determinations have initial jurisdiction with the Examiner and such a challenge was never made before the filing of the Reply Brief¹. The Appellants' asserting the priority date of a parent application for the first time in their Reply Brief circumvents the Examiner's conducting such required determinations.

Appellants' arguments to the remaining 35 U.S.C. § 103(a) rejections, namely, Ragsdale-Elliott in view of Examiner's Official Notice and Ragsdale-Elliott in view of Kurland, are each based on Appellants' position that Ragsdale-Elloit fails to disclose advertisements. For the reasons set forth above, Appellants' arguments are thus not persuasive as to error in the rejection.

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claim 1, 3, 5, 7, 12, 14, 16, 17, 19, 57-60 and 65 under 35 USC §102 as being anticipated by Ragsdale-Elliott.

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 8-11, 13, 15, 18, 20, 24, 25, 29, 30, 32-35, 39-47, 54-56, 61-64, and 66-73 under 35 USC §103(a) as being unpatentable over Ragsdale-Elliott in view of Examiner's Official Notice.

We conclude the Appellants have not shown that the Examiner erred in rejecting claim 21-23 and 36-38 have been rejected under 35 USC §103(a) as being unpatentable over Ragsdale-Elliott in view of Kurland.

¹ The record shows that Ragsdale-Elliott was used as a reference by the Examiner as early as in the Office Action dated 1/26/2005, with no challenge being made by Appellants in the ensuing Responses filed onwards of July 28, 2005, the date of Appellants' next Response.

DECISION

The decision of the Examiner to reject claims 1, 3, 5, 7-25, 29, 30, 32-47, and 54-72 is AFFIRMED.

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